

### REMARKS

Claims 19-28, 30-34 and 26-38 are currently pending and presented for examination. Claims 19-20, 22, and 34 stand rejected under 35 USC 102 as being anticipated by, or in the alternative under 35 USC 103 as being unpatentable over Simkovich (US 4711665). Claims 34-36 stand rejected under 35 USC 102 as being anticipated by Buckland (US 2290007).

Claim 21 stands rejected under 35 USC 103 as being unpatentable over Simkovich (US 4711665). Claims 22-28, and 30-33 stand rejected under 35 USC 103 as being unpatentable over Czech (US 5939204) in view of Corwin (US 4999158). Claims 34-38 stand rejected under 35 USC 103 as being unpatentable over Minato (US 3902823) in view of Buckland (US 2290007).

#### Response to Rejections Under Section 102/103:

Claims 19-20, 22, and 34 stand rejected under 35 USC 102 as being anticipated by, or in the alternative under 35 USC 103 as being unpatentable over Simkovich (US4711665). Regarding the basic and novel characteristics of the invention, Applicant notes that in the originally filed specification, paragraphs 11, 12, and 29, Applicant specifies

The protective layer 7 combines a good resistance to corrosion with a particularly high stability with respect to oxidation and is also distinguished by **particularly good ductility properties**, making it especially well qualified for use in a steam turbine in particular in the event of a further increase in the inlet temperature.

Together with the compositions specified in paragraphs 13 and 14, Applicant believes that the basic and novel characteristics have been clearly indicated.

In the interest of expediting prosecution, Applicant has amended claim 19 to eliminative the “essentially of” language. Simkovich teaches an oxidant resistant alloy that comprises  $\text{Si}_3\text{N}_4$ , which is not included in, and teaches away from, the limitations of Applicant’s claim 19. In addition, Applicant has amended claim 19 to include into the selected group the element yttrium which the Applicant has considered as separate from the rare earth elements.

In view of the above, Applicant respectfully requests the 35 USC 102/103 rejection of claim 19, and claims 20-21, which depend from and include all the limitations of claim 19, based on Simkovich, be withdrawn.

Response to Rejections Under Section 102:

Claims 34-36 stand rejected under 35 USC 102 as being anticipated by Buckland (US 2290007). Applicant has amended claim 34 to claim a ferritic metallic protective layer **consisting** of. Buckland teaches alloys having compositions having elements such as nitrogen, carbon, manganese which are not included in, and teaches away from, the limitations of Applicant's claim 34.

In view of the above, Applicant respectfully requests the 35 USC 102 rejection of claim 34, and claims 35-36, which depend from and include all the limitations of claim 34, based on Buckland, be withdrawn.

Response to Rejections Under Section 103:

Claim 21 stands rejected under 35 USC 103 as being unpatentable over Simkovich (US 4711665). Claim 21 depends from and includes all the limitations of claim 19. Claim 19 survives application of Simkovich under 35 USC 102 and thus survives application of Simkovich under 35 USC 103 for the same reason. Applicant respectfully requests the 35 USC 103 rejection of claim 21, based on Simkovich, be withdrawn.

Claims 22-28, and 30-33 stand rejected under 35 USC 103 as being unpatentable over Czech (US 5939204) in view of Corwin (US 4999158). Applicant has amended claim 22 to claim "consisting" and has eliminated "up to 0.7 % (wt%) of at least one metal selected from the group consisting of scandium and the rare earth elements." (Zero wt% was included in the claim language.) Czech teaches a protective layer that includes "at least one reactive element selected from the group consisting of yttrium, scandium, and the rare earth elements" and thus teaches away from limitations in Applicant's claim 22 (Column 1, lines 18-20). Applicant respectfully requests the 35 USC 103 rejection of claim 22, and claims 23-28, and 30-33, which depend from and include all the limitations of claim 22, based on Czech and Corwin, be withdrawn.

Claims 34-38 stand rejected under 35 USC 103 as being unpatentable over Minato (US 3902823) in view of Buckland (US 2290007). The Examiner states Minato does not "teach a protective layer" and thus relies on the teaching of Buckland. In view of Applicant's argument for the 102 rejection Applicant respectfully submits that claim Buckland does not teach or suggest the protective layer as claimed in claim 34. Applicant respectfully requests the 35 USC

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103 rejection of claim 34, and claims 25-38, which depend from and include all the limitations of claim 34, based on Minato and Buckland, be withdrawn.

Conclusion

Applicants respectfully request that the Examiner reconsider the rejections and timely pass the application to allowance. All correspondence should continue to be directed to our below-listed address. Please grant any extensions of time required to enter this paper. The commissioner is hereby authorized to charge any appropriate fees due in connection with this paper or credit any overpayments to Deposit Account No. 19-2179.

Respectfully submitted,

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